

REMARKS

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-5 were originally presented for consideration in this application. Claims 6-10 were added by preliminary amendment. Claims 5 and 9 have been canceled above without prejudice or disclaimer. Accordingly, claims 1-4, 6-8 and 10 are currently pending in this application.

The following rejections, objections, and requirements were set forth in the Office Action:

1. The drawings are objected to for failure to show a feature recited in claim 5;
2. Claim 5 is objected to for lack of antecedent basis for a limitation recited in the claim;
3. Claims 3 and 4 stand rejected as indefinite under 35 USC §112;
4. Claims 1-4 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 6,173,788 to Lembcke et al.;
5. Claims 1-4 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,899,631 to Clark; and
6. Claim 5 stands rejected under 35 USC §103 as being unpatentable over Lembcke in view of U.S. Patent No. 4,202,087 to Wilderman.

Regarding the objections to the drawings and to claim 5, please note that this claim has been canceled above. The objections are thus obviated.

Regarding the indefiniteness rejections of claims 3 and 4, please note that amendments to these claims in the preliminary amendment filed September 7, 2007 resolved these issues. It appears that the amendments to the claims made in the preliminary amendment were not considered prior to issuance of the Office Action, due to the short period of time separating the preliminary amendment and the Office Action.

Regarding the anticipation rejections of claims 1-4, please note that independent claim 1 has been amended above to make it clear that the swellable packer includes a seal material which swells in response to contact with a swell-activating material. In contrast, Lembcke describes a packer which is conventionally set by longitudinally compressing the seal element to extend it radially outward, and Clark describes a packer which is set by inflating a seal element.

Since neither of the Lembcke and Clark references describes the features of the invention now recited in claim 1, the references cannot anticipate this claim. Therefore, withdrawal of the rejections of claim 1 and its dependents is respectfully requested.

Unfortunately, claims 6-10 were not considered before issuance of the Office Action. However, independent claim 6 has been amended above in a manner similar to the amendment made to independent claim 1 and discussed above, and so it will be appreciated that claim 6 and its dependents are also allowable over the cited references.

Regarding the obviousness rejection of claim 5, this claim has been canceled, and so the rejection is obviated.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-4, 6-8 and 10 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

SMITH IP SERVICES, P.C.

/Marlin R. Smith/

Marlin R. Smith
Attorney for Applicant
Registration No. 38,310

Dated: December 9, 2007

P.O. Box 997
Rockwall, Texas 75087
(972) 516-0030 (phone)
(972) 516-0608 (fax)

I hereby certify that this correspondence is being
filed in the U.S. Patent and Trademark Office
electronically via EFS-Web, on _____.
